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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/597,542	07/28/2006	Thomas McGee	102790-172 (30051 US)	2514
27389	7590	09/23/2009		
NORRIS, MCLAUGHLIN & MARCUS 875 THIRD AVE 18TH FLOOR NEW YORK, NY 10022			EXAMINER BETTON, TIMOTHY E	
			ART UNIT	PAPER NUMBER
			1617	
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			09/23/2009	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/597,542	<b>Applicant(s)</b> MCGEE ET AL.	
	<b>Examiner</b> TIMOTHY E. BETTON	<b>Art Unit</b> 1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 6-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>See Continuation Sheet</u> .                                  | 6) <input type="checkbox"/> Other: _____                          |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :4 sheets, 8/21/2006; 5 sheets, 7/28/2006.

## **DETAILED ACTION**

Applicant's election with traverse of Group I, claims 1-5 in the reply filed on 18 July 2008 is acknowledged.

Claims 6-13 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Group II, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 18 July 2008.

### **Restriction/ Election**

Applicant's election with traverse of Group I, claims 1-5 in the reply filed on 18 July 2008 is acknowledged. The traversal is on the grounds that the subject matter of the claims are sufficiently proximate and overlapping in technical nature that a search on one group of claims would likely result in a sufficiently broad search ample to assess the patentability of *all* of the claims. This is not found persuasive because the traversal is not persuasive because regarding the response to the Lack of Unity, the burden of search is not a consideration at all in a Lack of Unity requirement. The written opinion found art against the composition claims 6-13. As this is the case, the compositions are not "special" as a shared technical feature with the methods of claims 1-5, hence Lack of Unity is held on this basis alone.

Further, this case is a 371 of PCT/CH05/00063, and the papers filed in the instant application on 7-28-06 include a written opinion. The documents cited on the written opinion are not identified (i.e. Documents D6, D7, D8, D9 and D10.) However, documents D1-D5 are identified therein, but the "cited relevant passages" that the European examiner says are provided are absent in the application.

The following is the section of the document with relevant citations:

The common subject-matter linking together the different embodiments of present independent claims 1, 6 and 10-13 is a composition which is suitable for preventing the growth of fungi on substrates and imparting thereto a desired odour and which contains at least two O-containing organic fragrance compounds.

Said common concept is not new, in particular in view of the following documents: DE 36 11 265 (D1), EP 0 451 889 (D2), CH 690 263 (D3), WO 01/24769 (D4), EP 1 214 879 (D5) and XP-001062022 (D6). Indeed, all these documents disclose compositions containing at least two O-containing organic fragrance compounds, whereby said combinations of compounds prevent the growth of fungi on substrates while imparting a desired odour thereto (see cited relevant passages in the search report).

Also, in the written opinion, regarding Item VIII (Certain Observations on the international application), it is noted that four of the compounds of claim 3 lack antecedent basis in the independent claim 1, from which claim 3 depends. These are boxed hereinbelow:

3. A method according to claim 1, in which at least one of the fragrance components is selected from the group consisting of:

3-(4-methoxyphenyl)-2-methyl- propanal;

alpha-methyl- 1,3-benzodioxole-5-propanal;

3-methyl-5-phenyl- pentanal;

6-Methoxy-octahydro-4,7-methano-indene-1-carbaldehyde;

undec-10-ene-1-ol;

4-methyl-5-pentyl-dihydro-2(3h)- furan-2-one;

8-methyl-1-oxaspiro[4.5]- decan-2-one;

8,8-Dimethyl-1,2,3,4,5,6,7,8-octahydro-naphthalene-2-carbaldehyde;

6,6-dimethyl-bicyclo[3.1.1]hept-2-ene-2-propanal; and

5-methyl-7-(1-methylethyl)-bicyclo[2.2.2]oct-5-ene-2-carboxaldehyde.

Hence, the requirement is still deemed proper and is therefore made *FINAL*.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

- 1 Determining the scope and contents of the prior art.
- 2 Ascertaining the differences between the prior art and the claims at issue.
- 3 Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various

claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hanada et al (EP 1214879) in view of Pika et al. (USPN 6133228).

Hanada et al. teach an antifungal fragrance composition containing as its active ingredients: (a) at least one type of fragrance component selected from the group consisting of an aliphatic or aromatic aldehyde having 5 to 16 carbon atoms, an aliphatic alcohol having 5 to 16 carbon atoms and a phenol, and (b) at least one type of compound selected from the group consisting of an aliphatic or aromatic aldehyde, aliphatic alcohol, phenol, acetal and ester demonstrating synergistic effects in the presence of said fragrance component. The present antifungal fragrance composition demonstrates antifungal activity by adding in a small amount that only has a minimal effect on the scent of the fragrance component (abstract only). Hanada et al. teach that fragrant chemical products have been widely known to have antibacterial and antifungal activity (para 5, l/s 1 and 2) and that the essential oils and fragrant chemical products can be used in the vapor state as a diffusion preventive agent (para 6, l/s.1, 2, and 5) (para 9, l. 1). Although these fragrant components have antibacterial and antifungal activities, these properties are not so potent (para 7, l. 1). Hanada et al. teach the method whereby one fragrant component is added/mixed with another fragrant component thereby causing an enhancement in synergism (para 9, whole paragraph). Specifically, Hanada et al. teach aliphatic and aromatic alcohols and aldehydes which would also constitute reasonably as cyclic alcohols and aldehydes because of their emission of odor, demonstrate synergistic effects in combination together (page 3, lines 10-14, also see lines 16-27). Hanada et al. does not expressly teach 3-methyl-5-phenyl- pentanal or 3-methyl-5phenyl-pentanol, which are well known cyclic aldehydes and alcohols respectively.

Pika et al. teach a fragrance delivery system which releases fragrant alcohols upon exposure to light. The system comprises alcohols in the form of 2-benzoyl benzoates of a general formulae which

can comprise various substituents R.sub.1 - R.sub.5 as defined in the application, and a substituted R\* which is the organic part of the fragrant alcohol (abstract only). Pika et al. teach 3-methyl-5-phenyl-pentanol (col.4., l.2) among other equivalent compounds (e.g. 2,6-nonadienol) for the purpose of treating surfaces. See Pika et al. col. 3, l. 27.

It would have been prima facie obvious to the one of skill at the time of invention to recognize a reasonable expectation of success via the combining and incorporating together the references of Hanada et al. and Pika et al. Hanada et al. essentially teaches the central concept of the invention and gives reasoning as to the link between the fragrant components' ability to emit a pleasing fragrance (Hanada et al. para 7, l. 51) while also exemplifying antifungal activity. Hanada et al. teaches various combination/mixtures of the fragrant components to achieve the enhancement of synergism, and the vapor and liquid states of such components. Although Hanada et al. does not explicitly teach 3-methyl-5-phenyl-pentanol, Pika provides the motivation to use 3-methyl-5-phenyl-pentanol in the invention of Hanada et al for the same purposes of imparting fragrance to surfaces being treated. Therefore, it would have been obvious to use any mixture or combination of antifungal and fragrance compounds as taught by Hanada et al. in view of Pika et al. since Pika et al. teaches the equivalence of useful alcohols in the form of 2-benzoyl benzoate esters. See Pika et al. at column 3, line 65 through column 4, line 15.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy E. Betton whose telephone number is (571) 2729922. The examiner can normally be reached on Monday-Friday 8:30a - 5:00p. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications

is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TEB

/SREENI PADMANABHAN/  
Supervisory Patent Examiner, Art Unit 1617